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In re Application of:	:	
DA SILVA RODRIGUES, et al.	:	DECISION
U.S. Application No.: 10/581,774	:	
PCT No.: PCT/IB2004/004350	:	
Int'l Filing Date: 10 December 2004	:	
Priority Date: 11 December 2003	:	
Attorney's Docket No.: SC3	:	
For: SMOKING ARTICLE	:	

This decision is issued in response to the declaration filed herein by applicants and the "Notice Of Death Of Joint Inventor Under MPEP 409" filed 29 August 2006. No petition fee is required.

BACKGROUND

On 10 December 2004, applicants filed international application PCT/IB2004/004350. The application claimed a priority date of 10 December 2004, and it designated the United States. On 30 June 2005, the International Bureau (IB) communicated a copy of the international application to the United States Patent and Trademark Office (USPTO). The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 11 June 2006.

On 06 June 2006, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the small entity basic national fee and a copy of a PCT Rule 4.17(iv) declaration filed in the international application and executed by both of the inventors herein.

On 29 August 2006, applicants filed additional materials, including a "Notice Of Death Of Joint Inventor Under MPEP 409" indicating that inventor Antonio Augusto DA SILVA RODRIGUES was now deceased.

DISCUSSION

The PCT Rule 4.17(iv) declaration document filed by applicants during the international phase was not submitted at the same time as the international application. Accordingly, as set forth on the face of the declaration (and in the instructions thereto), the declaration was required to identify the international application number. The declaration executed by the two inventors and filed in the international application did not, however, include the required international

application number. The declaration therefore fails to properly identify the application to which it was directed and cannot be accepted herein in satisfaction of the requirements of 37 CFR 1.497.

It is noted that applicants included with the national stage materials filed 06 June 2006 a copy of the PCT Rule 4.17(iv) declaration that lists the international application number. However, a comparison of this declaration with that filed in the international phases reveals that the international application number has simply been added to the already-executed declaration. The declaration filed on 06 June 2006 therefore includes an impermissible post-execution modification, and is thus unacceptable (see MPEP section 602.01).

Based on the above, applicants have not yet filed an acceptable declaration in compliance with 37 CFR 1.497. A Notification Of Missing Requirements (Form PCT/DO/EO/905) requiring submission of an oath or declaration, as well as the surcharge for filing the oath or declaration later than thirty months after the priority date, will be issued herein.

Because one of the applicants is now deceased, any declaration filed herein must be executed by the surviving inventor and on behalf of the deceased inventor in compliance with 37 CFR 1.42 and 1.497(b)(2).

37 CFR 1.42 states in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Pursuant to MPEP section 409.01(a), application may be made by the heirs of the inventor, as such, if there is no will or the will did not appoint an executor and the estate was under the sum required by state law for the appointment of an administrator.

37 CFR 1.497(b)(2) states:

If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Pursuant to 37 CFR 1.497(b)(2), a declaration submitted under 37 CFR 1.42 must provide the name, citizenship, residence and mailing address of the legal representative, as well as the name and citizenship of the deceased inventor. The declaration must also satisfy all other requirements of 37 CFR 1.497 (for example, the declaration must name all of the inventors herein).

CONCLUSION

The declaration filed in the international phase, and the modified version of this declaration filed herein on 06 June 2006, are **REJECTED** for failure to comply with the instructions for declarations filed under PCT Rule 4.17(iv) and the requirements of 37 CFR 1.497.

The application is being referred to the National Stage Processing Branch of the Office of PCT Operations for further processing in accordance with this decision, including the mailing of a Notification Of Missing Requirements (Form PCT/DO/EO/905) requiring submission of a properly executed oath or declaration (submitted in accordance with 37 CFR 1.42 with respect to the deceased inventor), as well as the surcharge for filing the oath or declaration later than thirty months after the priority date

A handwritten signature in black ink, appearing to read 'R M Ross'.

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